

REMARKS

Claims 1-20 remain in the application. All of the claims have been amended. Claims 11, 12 and 13 have been provided with their proper status identifiers so as to be responsive to the communication of August 27, 2008.

In the Examiner's communication dated April 23, 2008, the Examiner has applied U.S. Patents Nos. 6,575,171 and 5,339,477 to Jacquin and Warner et al., respectively against the claims on file. In particular, the Examiner has rejected all claims currently on file under 35 USC 103(a) as being unpatentable over Jacquin in view of Warner et al.

The Examiner alleges that Jacquin discloses a nail polish removing device (figs. 12-14) comprising a container (400) including a nail polish removing solution compartment (50), an opening (20) adapted to receive a portion of a foot to be cleaned in a lateral manner, a porous and pliable medium (25) *being in contact with the solution* (see fig. 1); the container further having a ledge (15, col. 3, lines 45-51) for resting the user's foot, the ledge being disposed at bottom of the opening, a cover (131) for sealing the compartment (50) against a loss of the solution (emphasis applied). The Examiner further alleges that Jacquin discloses that the nail polish solution is being transferred from the compartment to the porous member by a pump (55), and the solution is uniformly absorbed in the porous member by a combination of agitation, which is caused by rotating action of the porous member and capillary action. In addition, the device of Jacquin further has legs (see fig. 5) to support the device. The Examiner acknowledged that Jacquin fails to show the porous member having a slot and the container being made of plastic. However, the Examiner alleges that Warner et al., discloses a nail polish removing device (fig. 3) comprising a sponge member (80) with a slot or cavity (86) dimension to receive the foot or finger to be cleansed.

The Applicant respectfully traverses this rejection and requests reconsideration of the claims presently on file. Claims 1 and 10 are independent claims and claims 2 to 9 and 11 to 20 are, respectively, dependent claims depending directly therefrom.

The present invention, as described and claimed herein, is directed to a nail polish removing device having a container with a side wall having an opening and a porous and pliable medium disposed in the container. As noted on page 4 of the subject application, the container has a nail polish removing solution compartment in a bottom part thereof. The porous and pliable medium is disposed in the container at least partly above the solution compartment and in contact with the solution contained therein. In addition, the container is provided with an opening disposed above the solution compartment, the opening being dimensioned to receive that portion of a foot to be cleansed or treated. As further noted on page 4 when the device is in use, the solution at least partly permeates the porous and pliable medium. The medium has a slot or cavity dimensioned to receive that portion of the foot to be cleansed or treated, the slot or cavity being disposed in alignment with the opening so that a portion of a user's foot can be inserted laterally through the opening into the slot or cavity.

It is submitted that the prior art references while generally related to the subject application are significantly deficient and fail to render the claims currently on file anticipated and/or obvious.

The Applicant has carefully studied the devices of Jacquin and Warner et al. and concluded that they are rather complex and complicated, involving many parts, especially moving parts, that are prone to mechanical failure. Simply put, the subject device, as fully described and distinctly claimed herein, was made in recognition of the problems associated with such devices, as those described in the cited references.

The Applicant submits that, contrary to what the Examiner alleges, nowhere within the four corners of Jacquin is there any mention or suggestion that the generally cylindrical rotatable sponge or scrubbing member **25** is in contact with the nail removing fluid of the container **50**. This conclusion: that in the device of Jacquin the rotatable scrubbing member is not in contact with the solution is evident from the drawings thereof. Furthermore, Jacquin unequivocally states in column 2, lines 22 to 25: **"the hand activated pump or automated motor includes a downwardly extending nozzle which moves toward the rotatable brush, sponge, or scrubbing member during engagement of**

the hand activated pump or automated motor such that nail polish removing fluid is delivered in close proximity to the brush, sponge, or scrubbing member”.

It is submitted that, according to Jacquin, it is not the fluid of the container 50 that is in contact with the scrubbing member, but the plurality of fingernails of the hand or toenails of the foot. In that respect, Jacquin in column 2 lines 5 to 10 discloses that “a rotatable brush, sponge, or scrubbing member is coupled to the base such that *the plurality of fingernails of the hand or toenails of the foot* are positionable *in contact* with the rotatable brush, sponge, or scrubbing member when the plurality of fingers or toes are positioned in the first area”(emphasis applied).

It is, therefore, strongly submitted that it is crystal clear from the description and drawings of Jacquin that the rotatable scrubbing member **25** is not in contact with the nail removing fluid of the container **50**. Jacquin specifically states in column 4, lines 2 to 4 that “**container 50 maintains the supply of nail polish removing fluid separate from area 20 of base 15 and from sponge or member 25**”. Hence, it should be perfectly clear to any person skilled in the art that Jacquin discloses a system in which the fluid is delivered from the container **50**, which is completely separated from the area 20, to the rotatable scrubbing member **25**, by a pump **55** through a fluid path that ends with a shooter or spraying device **110**. From the teachings and drawings of Jacquin, it can be concluded that the container **50** containing nail removing fluid is situated above or at the same level as the rotatable scrubbing member **25**.

In complete contrast, in the present invention the nail polish removing device has a container which defines a polish removing solution compartment in a bottom part thereof. The Examiner’s attention is respectfully drawn to the fact that, in the present invention, the solution compartment is not separated from the container. In addition, the porous and pliable medium is disposed in the container above the solution compartment and in direct contact with the solution contained therein.

It is further submitted that, contrary to the teachings of Jacquin, the porous and pliable medium of the subject invention is not designed to be rotated. The Applicant submits that nowhere

does Jacquin mention, disclose, or suggest that the scrubbing member **25** is fixed.

The Examiner refers to Fig. 5 to support the allegation that the device of Jacquin has legs to support the device. The Applicant believes that the protrusions illustrated at the bottom of the Jacquin's device are not legs. It is firmly and respectfully submitted that the subject feature is simply not shown in any figure of Jacquin's drawings and there is no discussion provided by Jacquin.

In stark contrast, the subject invention provides non-skid means for allowing useful positioning of the device, such as suction cup feet or non-skid pads. The non-skid means may be affixed to a floor or other surface and the user may sit in a comfortable position so as to allow convenient use of the device. Jacquin does not set forth these features.

The Applicant believes that all claims currently on file are not obvious because Jacquin and Warner et al., either considered separately or in combination, do not teach, disclose or suggest all of the limitations of claims 1 to 20. Applicant respectfully points out that to establish a prima facie case of obviousness, a prior art reference (or references when combined) must teach or suggest all of the claim limitations (See MPEP 2143).

As discussed in detail above, Jacquin does not set forth each and every element in claims 1 and 10, and the claims dependent therefrom. The Applicant believes that Warner et al. do not either. It appears that Warner et al. disclose a motorized device for removing nail coatings having, *inter alia*, a cartridge with a flexible foam body saturated with a solvent capable of removing the coating. The Applicant submits that the motorized device of Warner et al. is designed with a finger-receiving slit such that only one finger can be inserted therein to remove the nail coating.

Accordingly, in view of the above remarks reconsideration of the 103 rejection and allowance of all the claims of the present application is earnestly requested.

CONCLUSION

The Applicant respectfully requests reconsideration of this application. Applicant believes that claims 1 to 20 are in condition for allowance and respectfully requests that a timely Notice of Allowance be issued in this case. The Applicant has effected minor revisions and refinements to claims 1 to 20 to remove reference characters included therein. The amendments are not being made for reasons related to patentability and do not add any new matter.

While no fee is believed due with this paper, authorization is hereby given to charge our deposit account, No. 50-1133, for any required fees.

Respectfully submitted,
McDermott Will & Emery LLP

Date: September 16, 2008

/Toby H. Kusmer/

Toby H. Kusmer, P.C.
Registration Number 26,418
McDermott Will & Emery LLP
28 State Street
Boston, Massachusetts 02109-1775
Telephone: (617) 535-4065
Facsimile: (617) 535-3800
E-mail: tkusmer@mwe.com